UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,124	01/04/2002	Luh-Yuan Lin	LINL3001/EM	3111

7590 03/24/2004

BACON & THOMAS
4th Floor
625 Slaters Lane
Alexandria, VA 22314

EXAMINER	
MANAHAN, TODD E	
ART UNIT	**PAPER NUMBER**
3732	5

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/035,124	Applicant(s) LIN ET AL.	
	Examiner Todd E. Manahan	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 January 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the claim recitation of the linguoplate ending from near one end of the arch to near the other end of the arch must be included in the specification or the subject matter cancelled from the claim. No new matter may be entered.

Drawings

The drawing corrections received on 14 January 2004 have been approved by the Examiner. It is noted that since applicant has not filed corrected drawing incorporating these changes, the drawings originally filed on 04 January 2002 are now objected to for failing to include these changes.

New corrected drawings are hereby required in this application incorporating these changes. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any

replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Willits et al. (United Sates Patent No. 5,364,269).

Willits et al disclose a partial denture in the form of an arch comprising at least one denture tooth 18 on one side of the arch held by a resin material 12,14,16. The resin is supported by a metal framework of a metal casting comprising a linguoplate 30. The linguoplate comprises a lingual portion having a shape conformable to the shape of the lingual surface of teeth and alveolar mucosa from a tooth adjacent the missing tooth to another side of the dental arch of the patient for intimately contacting the lingual surface of the teeth and the alveolar mucosa. A tissue portion extends from the lingual portion and has a shape conforming to the shape of the portion of the rear gum tissue connecting to the teeth and the alveolar mucosa so that there is no gap between the teeth and the portion of the gum tissue not covered by the linguoplate (see figure 4). The metal casting further includes rests 34 provided on the lingual portion for engaging the teeth. It is noted that the linguoplate extends from "near" one end of the arch to "near" the other end of the plate. Willits et al disclose the invention essentially as claimed except for the tissue portion having a margin 3-10 mm away from the lingual portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create the margin of the tissue portion 3-10 mm away from the lingual portion, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. Regarding claim 7, rests 34 also constitute "clasps for engaging with one or more teeth of said patient" (see col.2, lines 4-15).

Response to Arguments

Applicant's arguments filed 14 January 2004 have been fully considered but they are not persuasive.

In response to applicant's arguments that the Examiner has failed to make a *prima facie* case of obvious pursuant to MPEP 2131, it is noted that MPEP 2131 deals with anticipation under 35 USC 102(a), (b), and (e) and not obviousness. Applicant further states that the examiner has failed to provide rationale to support the obviousness rejection because there is no explicit teaching of such modifications in the prior art. It is noted that the rationale may be in a reference, or reasoned from common knowledge in the art, scientific principles, art-recognized equivalents, or legal precedent (see MPEP 2144). In the instant case the rationale was based upon legal precedent of finding optimum or workable ranges (see MPEP 4144.05).

Applicant further argues that Willits et al. does not show the linguoplate extending from one side of the arch to the other and that this is an important feature of applicant's invention. It is noted that this "important feature" was not articulated in applicant's original specification in any manner which would lead on to believe that this feature is not of great importance as applicant now argues. (It is to be noted that omission of critical or important features from the specification could render the disclosure non-enabling under the first paragraph of 35 USC 112). Furthermore, the terminology "near" is a relative term and it is believed that the linguoplate of Willits et al does extend from "near" one end of the arch to "near" the other end of the arch and further appears to be substantially the same as the embodiment shown in figure 3 of the instant application.

In response to Applicant's argument that Willits et al includes additional structure not required by Applicant's invention, it must be noted that Willits et al. disclose the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant.

In response to applicant's direction to MPEP 2144.08 that all rebuttal arguments and evidence must be considered, all of applicant's arguments have been considered and found not to be persuasive. Applicant has not provided any evidence showing that the ranges claimed are critical to applicant's invention and thus non-obvious.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 703 308-2695. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 703 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Todd E. Manahan
Primary Examiner
Art Unit 3732

T.E. Manahan
23 March 2004